REMARKS

Claims 1-64 were pending. Claim 65 and 78 are amended and claims 22-27 and 30-36 are canceled. The pending claims are now claims 65-85. No new matter has been added. The amendments to claims 65 and 78 are solely to address the Examiner's rejection under 35 U.S.C. § 101 as described below, and are not intended to alter the scope of the claims.

The Examiner rejected claims 65-84 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Claims 65 and 78 are amended to recite explicitly that video programming content and advertisements are displayed to a viewer's access device. Method claims 65-84 are thus "tied to a particular machine or apparatus," and recite patentable subject matter. See *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008)(en banc). Accordingly, the Examiner is asked to withdraw the rejection under 35 U.S.C. § 101.

Next, the Examiner rejected claims 65-85 under 35 U.S.C. § 112, first paragraph, as lacking written description. In particular, the Examiner asserted lack of support for awarding value to the viewer responsive to the viewer stopping display of an advertisement beyond a threshold amount of time—that is, "responsive to the first amount of time exceeding a threshold amount of time associated with the advertisement, awarding value to the viewer."

Awarding value to the viewer depending on how much of the advertisement is watched by the video is well supported by the specification. For example, at paragraph [0030] of the specification as originally filed, the disclosure reads "[t]he value may also be prorated depending on the amount of the advertisement played, for example if user 150 decides to skip an advertisement part way through the commercial." Since the claimed limitation is supported by the specification, both the rejection under 35 U.S.C. § 112, first paragraph and the consequential rejection under the second paragraph should be withdrawn.

Claims 65-85 were rejected under 35 U.S.C. § 103(a) as unpatentable over DeLuca *et al* (DeLuca) in view of Jacobs.

Claim 65 as amended recites:

> A method for providing interactive advertising to an access device, the method comprising:
> receiving video programming content and advertisements;
> displaying to an access device of a viewer at least a portion of the received video programming content;
> automatically displaying to the access device of the viewer at least one of the received advertisements in addition to the displayed video programming content;
> receiving after a first amount of time a request from the viewer to stop displaying the displayed advertisement;
> responsive to the received request, stopping the display of the advertisement; and
> responsive to the first amount of time exceeding a threshold amount of time associated with the advertisement, awarding value to the viewer.

The claimed invention automatically displays advertisements to a viewer in addition to displayed programming content. When a request is received from a viewer to stop the displaying of the advertisement, the viewer is awarded value, provided the stop request is received after a threshold amount of time.

The combination of DeLuca and Jacobs does not disclose the claimed invention. DeLuca provides a way for users of a wireless device to get free services in exchange for choosing to view advertisements. (DeLuca, Abstract.)

According to the Examiner, DeLuca discloses the claimed step of automatically displaying advertisements in addition to displayed content at col. 11, lines 5-15. To the contrary, DeLuca discloses exactly the opposite—the user is required to manually select an advertisement/survey menu, and then to manually select an advertisement or survey from among a list of available advertisements and surveys. Only once the user has selected an ad to view is the ad shown on the display. DeLuca therefore does not disclose "automatically displaying to the access device of the viewer at least one of the received advertisements in addition to the displayed video programming content," as claimed.

Further, as the Examiner admits, DeLuca does not teach providing video programming content. Nor is this feature found in Jacobs. At best, Jacobs discloses that "Advertisements" may be available in multiple formats, including video. (See the definition of "Advertisements" in the table following paragraph [0032].) The advertisements in Jacobs, however, are in addition to "the primary content, e.g., e-mail messages". Indeed, nowhere does Jacobs disclose that the primary content supported by the advertisements, which Jacobs refers to as the software product, is video programming content. Jacobs states that "the principles of the present invention apply to on-line services where a provider, e.g., a software provider, desires to make its software available to users using a variety of payment options for a core set of software functions." Accordingly, Jacobs fails to teach at least the claimed step of "receiving video programming content and advertisements," or "displaying to an access device of a viewer at least a portion of the received video programming content."

Claim 65 is therefore patentable over the combination of DeLuca and Jacobs. Independent claims 78 and 85 are also patentable over the combination of references for analogous reasons. Dependent claims 66-77 and 79-84 are patentable as well, as each recites its own patentable features in addition to dependening from patentable independent claims.

If any matters remain outstanding prior to allowance of the claims, the Examiner is invited to contact the undersigned attorney at (415) 875-2358 or via e-mail at dbrownstone@fenwick.com. Applicants acknowledge that a copy of any electronic mail communications will be made of record in the application file per MPEP § 502.03.

Respectfully submitted,
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